

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Lance E. GOOD et al.

Group Art Unit: 2175

Application No.: 10/707,532

Examiner: T. VU

Filed: December 19, 2003

Docket No.: 115733

For: METHODS AND SYSTEMS FOR ENHANCING RECOGNIZABILITY OF OBJECTS
IN A WORKSPACE

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the May 21, 2008 Office Action and the August 6, 2008 personal interview, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-8, 10-21, 23-34 and 36-39 are pending.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiner Vu in the August 6 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

The Office Action rejects claims 1-4, 6-8, 10, 11, 13-17, 19-21, 23, 24, 26-30, 32-34, 36, 37, 39 and 40 under 35 U.S.C. §103(a) over U.S. Patent No. 6,968,511 to Robertson et al. (hereinafter "Robertson") in view of U.S. Patent No. 5,801,699 to Hocker et al. (hereinafter "Hocker"). This rejection is respectfully traversed.

The Office Action admits that Robertson fails to teach or suggest the predetermined distance as recited in the claims and asserts that Hocker discloses this feature. The Office

Action alleges that one of ordinary skill in the art would have been motivated to combine Robertson and Hocker "for managing, manipulating, organizing and classifying of displayed objects." This assertion is incorrect.

During the August 6 interview, the Examiner asserted that Hocker's method for grouping objects is an alternative to the method of Robertson. However, as discussed during the interview, Hocker does not recognize or solve the problem of Robertson, or disclose a relevant advantage over the method disclosed by Robertson, nor does the Office Action provide other objective evidence to support the assertion of obviousness. Therefore, it would not have been obvious to one of ordinary skill in the art to have modified Robertson in the manner suggested based on the teaching of Hocker. Applicants maintain that the alleged combination is a result of impermissible hindsight reconstruction using the roadmap provided by Applicants' disclosure.

The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). See also the Supreme Court's reasoning in *KSR v. Teleflex*, requiring explicit "articulated reasoning with a rational underpinning" to support a legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007), citing *In re Khan* 441 F.3d 997, 998 (Fed. Cir. 2006). As stated by the Supreme Court in *KSR*, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* The conclusory statements of the Office Action fail to provide the requisite rational underpinning to support a conclusion of obviousness in view of the above standard.

Additionally, ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art reference as a whole. Further, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Given the above alleged disclosures, as supplemented by the discussion below, it is unreasonable to conclude that this standard is met in the asserted combination of references.

Moreover, as discussed during the interview, modifying Robertson by Hocker would have rendered Robertson unsatisfactory for its intended purpose. In particular, Robertson specifically discloses the use of a cluster to define a group. As agreed to during the interview, in Robertson, a predetermined distance from the cluster defines the association of an object to the group. That is, if an object is moved within the predetermined distance from the cluster, the object is associated with and becomes a member of the group of the cluster. Hocker, on the other hand, associates an object to the group based on a distance between the object and the nearest point of the group to the object. As such, replacing Robertson's association of an object by the distance from the cluster with Hocker's association of an object by the distance from a group would have rendered Robertson unsatisfactory for its intended purpose. See MPEP §2143.01(V).

In addition, because such a modification would have altered the principle of operation of Robertson, that is, would have changed Robertson's specified way to define a group using a cluster, it would not have been obvious to have modified Robertson by Hocker in the manner suggested. See MPEP 2143.01(VI).

At least for these reasons, Applicants respectfully submits that the rejection is improper, and thus, claims 1-4, 6-8, 10, 11, 13-17, 19-21, 23, 24, 26-30, 32-34, 36, 37, 39 and 40 are allowable. Accordingly, withdrawal of the rejection is respectfully requested.

The Office Action rejects claims 5, 12, 18, 25, 31 and 38 under 35 U.S.C. §103(a) over Robertson and Hocker, in view of U.S. Patent No. 5,371,844 to Andrew et al. (hereinafter "Andrew"). This rejection is respectfully traversed.

As discussed above, the combination of Robertson and Hocker is improper. Andrew does not overcome the deficiencies of Robertson and Hocker with respect to independent claims 1, 14 and 27. Therefore, claims 5, 12, 18, 25, 31 and 38 are allowable at least for their dependence on independent claims 1, 14 and 27, respectively, as well as for the additional features they recite. Accordingly, withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: August 21, 2008

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